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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,353	06/30/2003	Kiyoshi Miyazaki	50630/DBP/A400	8167
23363	7590	06/03/2004	EXAMINER	
CHRISTIE, PARKER & HALE, LLP 350 WEST COLORADO BOULEVARD SUITE 500 PASADENA, CA 91105			KRAWCZEWICZ MYERS, LOUANNE C	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/611,353	<b>Applicant(s)</b> MIYAZAKI, KIYOSHI	
	<b>Examiner</b> Louanne C Krawczewicz Myers	<b>Art Unit</b> 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/30/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/7/03</u> | 6) <input type="checkbox"/> Other: _____  |

*LK Myers*

**Objection to the Drawing**

The following is a quotation of section (a) of 37 CFR 1.165:

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the Examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual reproduction.

The submitted photographic illustrations filed June 30, 2003 are objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustrations should not be mounted (37 CFR 1.84(e)).

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at:

<http://www.uspto.gov/web/offices/com/sol/oq/2001/week21/patwavr.htm>.

**Objection to the Disclosure**

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112 first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

- A. Page 1, lines 2, 30, and 32 and page 2, lines 2, 7, 23 and 24, Applicant sets forth that the instant plants' pollen parent is *Senecio heritieri*. It is not clear if Applicant intended "*heritieri*" or ~~–heritierii–~~ as this is an unrecognized species designation since it is not listed in the RHS Dictionary of Gardening. Correction to the specification and/or clarification is necessary.
- B. Page 1, line 2, Applicant states that the common name for the instant plants' parent is "Cineraria" which is listed as a species designation in the RHS Dictionary of Gardening. Correction to the specification and/or clarification is necessary.
- C. Page 1, line 14, Applicant sets forth " 'Cineraria' " in single quotes which is proper for a cultivar designation. -- "Cineraria" – would instead be more accurate.
- D. Page 1, line 30, Applicant should set forth in the specification the breeding line number or the name of the parental plant and if unnamed, state "an unnamed plant".
- E. Page 1, lines 12 and 16, Applicant states "flowers". It appears --inflorescences-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

- F. Page 1, lines 26 and 37, Applicant states "flower". It appears --inflorescence-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.
- G. Page 1, line 27, Applicant states "petals". It appears --ray florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.
- H. Page 1, line 27, Applicant states "disk flowers". It appears --disc florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.
- I. Page 2, line 15, Applicant states "No. PLANT12104, at 25.Sep.2001". It appears that -- U.S. Plant Patent Number 12,104 on 25, September, 2001-- would instead be more accurate.
- J. Page 2, lines 5-30, Applicant should set forth in the specification how and where the instant cultivar was first asexually reproduced.
- K. Page 2, lines 6 and 7, Applicant states "crossing with *Senecio cruentus* '8S-84e' and *Senecio heritierii*". It appears that --crossing of a plant of *Senecio cruentus*

'8S-84e' and a plant of *Senecio heritieri*-- would instead be more grammatically accurate. Correction to the specification and/or clarification is necessary.

- L. Page 2, lines 19 and 20, Applicant states that the instant cultivar is "uniform and stable in its characteristics". However, this recitation does not mean the instant plant reproduces true to type in successive generations of asexual reproduction. If the plant does reproduce true to type then applicant should also state in the specification --The new variety reproduces true to type in successive generations of asexual reproduction.—
- M. Page 2, line 25, it appears that Applicant should delete "the" in order to be grammatically correct.
- N. Page 12, lines 16, 20, 21, 25, 29, and 33, Applicant states "flower". It appears --inflorescence-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.
- O. Page 12, lines 18, 33 and 36, Applicant states "flowers". It appears --inflorescences-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

P. Page 12, lines 21, and 30, Applicant states "ray flowers". It appears --ray florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

Q. Page 12, line 30, Applicant states "ray flower". It appears --ray floret-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

R. Page 12, lines 21 and 24, Applicant states "petals". It appears --ray florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

S. Page 12, lines 26 and 27, Applicant states "petal". It appears --ray floret-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

T. Page 12, line 20, Applicant states "a disk". It appears --disc florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.



U. Page 12, lines 26 and 31, Applicant states " disk flower". It appears --disc floret-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

V. Page 12, lines 28 and 29, Applicant states "disk is". It appears --disc florets are-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

W. Page 12, line 30, Applicant states " disk flowers". It appears --disc florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

X. Page 13, line 2, Applicant states "flowers". It appears --inflorescences-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

Y. Page 13, lines 6,7,9, 20 and 35, Applicant states "flower". It appears --inflorescence-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

Z. Page 13, lines 8 and 37, Applicant states "petals". It appears --ray florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

AA. Page 13, lines 27 and 32, Applicant sets forth that the instant plants' pollen parent is *Senecio heritieri*. It is not clear if Applicant intended "*heritieri*" or --*heritierii*-- as this is an unrecognized species designation since it is not listed in the RHS Dictionary of Gardening. Correction to the specification and/or clarification is necessary.

BB. Page 13, line 36, Applicant states " disk flowers". It appears --disc florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

CC. Page 14, lines 1,3, and 7, Applicant states " disk flowers". It appears --disc florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

DD. Page 14, line 4, Applicant states " disk". It appears --disc florets-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

- EE. Page 14, lines 2, 4, and 6, Applicant states "petals". It appears --ray florets--may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.
- FF. Page 14, line 24, Applicant states "flowers". It appears --inflorescences-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.
- GG. Page 14, lines 27-35, Applicant should set forth in the specification the age of plants when described.
- HH. Page 14, line 30, Applicant states that the botanical characteristics of the instant plant (were taken) "7 months after cutting". This recitation is not understood as it is unclear what applicant is intending. Correction to the specification and/or clarification is necessary.
- II. Page 15, lines 3-11, Applicant should set forth in the specification additional information relative to the instant plant's stem/lateral branches including typical and observed length.

JJ. Page 15, line 11, Applicant states the instant plants' "length of third internode below flag leaf". This recitation is not understood as it is unclear what applicant is intending. Correction to the specification and/or clarification is necessary.

KK. Page 15, line 22, Applicant states in the specification that the instant plants' "Degree of Undulation – Fair". This recitation is vague as it is unclear what applicant is intending. Correction to the specification and/or clarification is necessary. Applicant should set forth in the specification additional information relative to the instant plants' leaves including the typical and observed leaf margin descriptor.

LL. Page 15, lines 12- 34, Applicant should set forth in the specification additional information relative to the instant plants' leaf venation including the pattern and coloration with reference to the employed color chart.

MM. Page 15, line 12-34, Applicant should set forth in the specification additional information relative to the instant plants' stipules including the typical and observed number per petiole, length, width, apex, base, margin and coloration (both surfaces) with reference to the observed color chart.

- NN. Page 15, lines 25 and 26, Applicant should set forth in the specification additional information relative to the instant plant's petioles including coloration with reference to the employed color chart.
- OO. Page 15, line 35 and page 16, lines 3, 19 and 20, Applicant states "flower". It appears --inflorescence-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.
- PP. Page 15, lines 36 and 37, and page 16, lines 1 and 21, Applicant states "flower cluster". It appears --inflorescence cluster-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.
- QQ. Page 16, lines 4, 9, and 18, Applicant states "disk flower". It appears --disc floret-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.
- RR. Page 16, line 5, Applicant set forth the "petal" colors. However, it is uncertain whether the colorations set forth are for the ray floret upper or lower surface or both surfaces. Applicant should set forth in the specification color

designations for the ray floret upper and lower surfaces with reference to the employed color chart.

SS. Page 16, lines 5, 11-16, Applicant states "petal". It appears --ray floret-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

TT. Page 16, lines 11-17, Applicant should set forth in the specification additional information relative to the instant plant's ray florets including the typical and observed ray floret base and margin descriptors and the typical and observed texture.

UU. Page 16, lines 19 and 20, Applicant should set forth in the specification additional information relative to the instant plant's pedicels including coloration with reference to the employed color chart.

VV. Page 16, lines 34-37, Applicant should set forth in the specification whether the instant plant produces pollen. If the instant plant produces pollen then applicant should set forth the typical and observed amount of pollen produced, such as scarce, moderate or abundant, and its generic coloration. If no pollen is produced, applicant should simply state in the specification that no pollen is produced.

- WW. Applicant should set forth in the specification additional information relative to the instant plant's flowers including number of flowers per lateral stem, number of flowers per plant, and typical and observed flowering season including the month
- XX. Applicants should set forth in the specification the time it takes to produce a flowering plant.
- YY. Applicant should set forth in the specification information relative to the instant plants' flower buds including hardness, diameter, length, form, surface, and color with reference to the observed color chart.
- ZZ. Applicant should set forth in the specification the lastingness of an - individual bloom, on the plant.
- AAA. Page 18, line 1 of the Claim, and page 19, line 11 of the Abstract, Applicant should delete "Genus" as this recitation is unnecessary.
- BBB. Page 19, line 14-15 of the Abstract, the sentence "There are several pubescences on its stem" is grammatically incorrect. Correction to the specification and/or clarification is necessary.

CCC. Page 19, line 15, Applicant states "flowers". It appears --inflorescences-- may be the more appropriate botanical term to use in these instances.

Correction to the specification and/or clarification is necessary.

DDD. Page 19, line 17, Applicant states "petal". It appears --ray floret-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

EEE. Page 18, line 18, Applicant states " disk flower". It appears --disc floret-- may be the more appropriate botanical term to use in these instances. Correction to the specification and/or clarification is necessary.

FFF. Throughout the specification, The Claim and the Abstract, Applicant should review the entire application for proper sentence structure and grammatical errors. There are many places throughout the specification that are confusingly written and do not make sense. Correction is necessary.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.



Claim Rejection

35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> Paragraphs

**Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.**

Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance.

Applicant should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

Applicant should note the new amendment format. (Web site stated below).

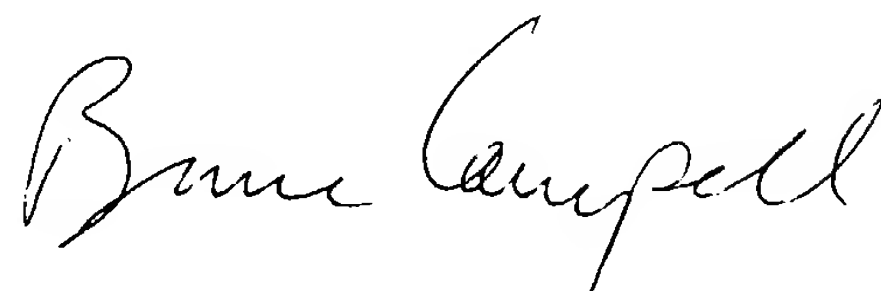
<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louanne C. Krawczewicz Myers whose telephone number is (571) 272-0979. The examiner can normally be reached on Monday and Thursday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone numbers for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.



LKM



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